

Remarks/Arguments

Claims 15 to 22 are pending. Independent Claim 15 has been amended to move part of the preamble into the body of the claim. The part moved was that the tube packaging laminate has an appearance similar to a hologram. Entry of the amendment to Claim 15 is requested.

The Office Action stated that the 35 U.S.C. 102 rejection of Claims 15, 16 and 22 as being anticipated by Yamaguchi et al. of record in the Office Action, mailed on May 18, 2004, pages 3 and 4, paragraph 6, has been withdrawn due to applicants' arguments in the paper filed on August 13, 2004. The Office Action stated that applicants' arguments regarding such 35 U.S.C. 102 rejection of Claims 15, 16 and 22 have been considered but are moot since the rejections have been withdrawn.

The Office Action stated that the 35 U.S.C. 103 rejection of Claims 17 to 21 over Yamaguchi et al. of record in the Office Action, mailed on May 18, 2004, pages 5 and 6, paragraph 7, has been withdrawn due to applicants' arguments in the paper filed on August 13, 2004. The Office Action stated that applicants' arguments regarding such 35 U.S.C. 103 rejection of Claims 17 to 21 have been considered but are moot since the rejections have been withdrawn.

Claims 15 to 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Touhsaent (U.S. Patent No. 5,013,353) in view of Kay (U.S. Patent No. 5,851,615). Applicants traverse this rejection.

The Office Action stated that applicants' arguments regarding the

35 U.S.C. 103 rejections of Claims 15 to 22 over Touhsaent in view of Kay have been fully considered but are not found persuasive. The Examiner's position is not supportable by the facts in the record or by the law.

The Examiner has the burden of proof and he has not carried his burden. The Examiner has not (and did not) factually established in the record a showing of *prima facie* obviousness.

M.P.E.P. 2141 requires the Examiner to apply the test for patentability under 35 U.S.C. 103(a) set forth by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, (1966). In order to provide a background for determining obviousness or nonobviousness, the Supreme Court set out four factual inquiries that must first be determined. The Supreme Court stated that determination of such four factual inquiries were mandatory. M.P.E.P. 2141 states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103."

The Examiner has not made in the record the mandatory resolution of the level of ordinary skill in the pertinent art. (The Examiner has not even addressed the matter in the record.) Therefore, this Section 103(a) rejection is defective on its face and in substance, and fails *ab initio*. The Examiner does not know who is one ordinarily skilled in the art.

With the failure to have made a valid Section 103(a) rejection, the Examiner has not carried his burden of proof, has not established *prima facie* obviousness and should withdraw this defective obviousness rejection.

No valid rejection can be made under Section 103(a) until, and unless, the four mandatory factual determinations of the Graham decision have been made, supported and stated in the record. This has not been done. Without compliance in the record with the Graham decision, there can never be a valid factual and legal establishment in the record of a *prima facie* showing of obviousness. In the case at bar, there is accordingly no showing of *prima facie* obviousness (for this and other reasons). The Examiner has not carried his burden of proof.

Furthermore, applicants have provided facts, arguments and law that would have rebutted any *prima facie* showing of obviousness.

The Examiner has incorrectly asserted that certain dependent claims are broader than the independent claim from which they depend. The Examiner's assertion is wrong in law and fact.

M.P.E.P. 2111.03 states:

"The transitional phrases 'comprising', 'consisting essentially of' and 'consisting of' define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim."

M.P.E.P. 2111.03 also states:

"The transitional phrase 'consisting of' excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)
('consisting of' defined as 'closing the claim to the inclusion of materials

other than those recited except for impurities ordinarily associated therewith.'). >But see *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331- 32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004) (holding that a bone repair kit 'consisting of' claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals because the presence of the spatula was unrelated to the claimed invention).< A claim which depends from a claim which 'consists of' the recited elements or steps cannot add an element or step. When the phrase 'consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986)." [Emphasis Supplied]

It appears that the Examiner has incorrectly tried to turn the exclusionary transitional phrase "consisting of" into the open transitional phrase "comprising" or "consisting essentially of".

35 U.S.C. 112, fourth paragraph, states:

"Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." [Emphasis supplied]

By statutory definition a dependent claim cannot be broader than the independent claim from which it depends.

Since the transitional term "consisting of" in independent Claim 15 lies between the preamble and the body, independent Claim 15 is exclusionary and fully closed. Dependent Claims 17 to 21 cannot be broader than independent Claim 15. Furthermore, if dependent Claims 17 to 21 were broader than independent Claim 15 they should have been rejected under Section 112, fourth paragraph, however, there is no such rejection in the record. Therefore, the subject dependent claims cannot be broader than the subject independent claim.

37 C.F.R. 1.75(c) states:

"One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. ... Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." [Emphasis supplied]

The Office Action stated: that Touhsaent teaches a packaging laminate which is used to overwrap food and non-food products in the shape of a tube; see the abstract; and that the laminate consists of a multilayered material having a layer structure of at least one functional layer of plastic as described in Touhsaent as a low temperature sealable coating, the function being a sealable layer. Applicants' claimed invention is patentable/unobvious as a whole, and the Examiner has not shown otherwise in the record.

The Office Action stated: that the functional layer contains at least one polyethylene (col. 1, lines 60 to 65); and that the non-adhesive functional layer also contains a lacquer coating (col.2, lines 8 to 14). This statement is not a complete description of those portions of Touhsaent. Touhsaent states:

"Optionally, a printed ink pattern may be applied to the surface of the sealable coating on the metal layer or on the coated or uncoated surface on the other side of the film, with an overlacquer applied to the surface containing the printed pattern to protect the pattern from damage. Also, optimally, another film may be laminated to any surface of the metallized film which does not contain an overlacquer." [Emphasis Supplied] [Column 2, lines 8 to 14]

The overlacquer in Touhsaent is only applied over a printed ink pattern. In applicants' claimed invention a printed ink pattern is only on the outer surface of lacquer coating (D) so Touhsaent directs away from applicants' claimed invention.

The Office Action stated, in response to applicants' argument, that Touhsaent requires a printed ink pattern if a lacquer coating is present.... Applicants traverse this statement as being an incorrect description of what applicants' quoted from Touhsaent. If Touhsaent uses a printed ink pattern, it must have an overlacquer layer on its outer facing surface. The overlacquer in Touhsaent is only applied over a printed ink pattern. This means Touhsaent must have its printed ink pattern, when used, between its lacquer layer and metal layer. Applicants never have a printed ink pattern between their lacquer layer and metal foil. Touhsaent directs away from applicants' claimed invention.

The Office Action stated that, first, limitations of Claim 15 do not require a lacquer layer between the functional layer and metal foil and since the printed ink pattern and lacquer layers are optional layers placed between the metal foil and functional layer so Touhsaent reads on the limitations of (A) of Claim 15. Touhsaent does not make applicants' claimed tube packaging laminate obvious by disclosing one layer thereof.

The Office Action stated that, with regards to Claims 17 to 21, which includes the limitation of a lacquer coating or melt extrudate in the functional layer, Claim 15 is not completely closed as written. Applicants traverse this statement as being untenable in law and fact. Every portion of Claim 15 after the transition phrase "consisting of" is closed by legal definition.

The Office Action stated that, although Claim 15 has the transition clause "consisting of" which requires the claim to be fully closed, the other limitations within the "consisting of" clause keep the claim open. Applicants traverse this statement as being in direct conflict with the law. The word "closed" means closed.

M.P.E.P. 2111.03 states:

"The transitional phrase 'consisting of' excludes any element, step, or ingredient not specified in the claim." [Emphasis supplied]

To put it succinctly, if it is not positively recited, it is excluded.

The Office Action stated that, in particular, (A) is "at least one functional layer of plastic with the functional layer thereof that forms outer surface of the multi-layered material being a non-adhesive functional layer". The elements that

(A) positively recites are, and only, "a non-adhesive functional layer of plastic or at least one functional layer of plastic". No non-plastic functional layer can be included. No layer that is not a plastic functional layer can be included. The remainder of (A) is a positively recited limitation that the outer surface of (A) and, hence, the multilayered material has to be a non-adhesive functional layer that is a type of functional layer of plastic because (A) is limited to "a non-adhesive functional layer of plastic or at least one functional layer of plastic". This is clearly so because the remainder of (A) recites "with the functional layer thereof" [Emphasis supplied].

The Office Action stated that, therefore, (A) in its broadest interpretation is defined as a layer having at least one functional layer of plastic, which means that the layer can be multi-layered and consist of layers other than the one functional layer of plastic. This statement is clearly incorrect – the word "thereof" destroys the Examiner's position. The Examiner must consider all of the words of (A). (A) is fully closed and the Examiner has not shown otherwise.

The Office Action stated that, in the case of Touhsaent, the (A) layer consists of a non-adhesive functional layer of plastic as the outer surface of (A) and a printed ink pattern and overlacquer as inner layers of (A). This is meaningless because Claim 15 excludes any layer that is not a functional layer of plastic and is arranged on metal foil (B) without any layer of any type of material between (A) and (B). The transitional phrase "consisting of" prevents any layer between (A) and (B).

The Examiner's attempt to show that (A) is not closed is illogical and incorrect. The Examiner's position is not correct in that which is the broadest interpretation of (A) and Claim 15, let alone the broadest reasonable interpretation.

The Office Action stated note that, although the claims are limited to only having A to E and optionally F and G, A and C are claimed in open language. Applicants traverse this statement as being clearly wrong. As applicants have shown herein, (A), (C) and the body of Claim 15 are fully closed.

Chisum, Donald S., "Patents", Vol. 2, Section 8.06[1], (2/91), page 8-101 states:

"'Consisting,' on the other hand, means that the claim covers devices having the recited elements and no more. If the invention is claimed as 'consisting' of elements X and Y, it will not literally read on or cover a device with elements X, Y and Z. The claim is thus 'closed'."

The Office Action stated that the laminate further consists of a metal foil or metal deposit layer (Figure 1) composed of aluminum (col. 4, lines 26 to 30). The overlacquer coating of Touhsaent has to have a printed ink pattern between it and the metal foil/deposited layer which arrangement is excluded from applicants' claimed invention. Also, nowhere does Touhsaent specify a metal "foil". Touhsaent concentrates on metal deposition.

The prior Office Action stated that optionally a printed ink pattern may be applied to the coated or uncoated surface opposite the sealable coating layer of the film (col. 2, lines 8 to 14). This statement is not complete as Touhsaent

requires an overlacquer coating on any such optional printed ink pattern, which means that, when Touhsaent uses a printed ink pattern, Touhsaent is automatically outside of (A) of applicants' claims.

The prior Office Action stated that Touhsaent fails to explicitly teach having an embossed design over whole or part of the surface of the metal foil layer. This statement is incorrect because, as noted herein, Touhsaent has other differences from applicants' claimed invention that prevents Touhsaent from resulting in or suggesting applicants' claimed invention. The Examiner has not provided any reasons, facts, etc., that would cause one ordinarily skilled in the art to ignore any of the requirements of Touhsaent in the quest for applicants' claimed invention.

The treated surface of the "surface treated polymer skin layer" of Touhsaent that is contact with the metal layer comprises a separate layer. Touhsaent states:

"Before applying the metal, primer or polymeric, film-forming coatings to the surfaces of the film substrate, as described hereinafter, the surfaces intended to receive the metal coating and optionally the opposite surface are treated to insure that the coatings will be strongly adherent to the film substrate, thereby eliminating the possibility of the coatings peeling or being stripped from the film. This treatment can be accomplished by employing known prior art techniques such as for example, film chlorination, i.e., exposure of the film to gaseous chlorine, treatment with oxidizing agents such as chromic acid, hot air or steam

treatment, flame treatment, corona discharge treatment, and the like.

Flame or corona discharge treatment of the surfaces is preferred in the production of the films of this invention." [Emphasis supplied]

[Col. 4, lines 1 to 14]

"Subsequently the HDPE skin layer was flame treated...."

[Example, Col. 8, lines 5 and 6]

"In accordance with this invention, a metallized multilayer film suitable for packaging applications is provided comprising a film substrate having in cross-section a polymer, e.g., polypropylene homopolymer, core layer, on at least one surface of which is a skin layer of a polymer having a lower melting temperature than the polymer of the core layer, the exposed surface of such skin layer having been treated, e.g., flame or corona discharge treated, prior to coating to increase its adherence to other materials, such film substrate containing a metal layer, e.g., of aluminum, deposited on said treated skin layer surface...." [Emphasis supplied] [col. 1, lines 51 to 61]

"A metallized multilayer packaging film comprising a film substrate having a polymer core layer on at least one surface of which is a first polymer skin layer having a lower melting temperature than that of said core layer, the exposed surface of said first skin layer having been treated prior to coating to increase its adherence to other materials, said film substrate containing a metal deposit obtained by a method selected from the group

consisting of vacuum deposition and sputtering on said treated first skin layer surface...." [Emphasis supplied] [Claim 1, lines 1 to 9]

"A metallized multilayer film comprising a film substrate having a polymer core layer, e.g., a polypropylene homopolymer (OPP), on at least one surface of which is a polymer skin layer having a lower melting temperature than that of said core layer, the exposed surface of skin layer having been treated, e.g., flame or corona discharge treated, prior to coating to increase its adherence to other materials, the film substrate containing a metal deposit, e.g., aluminum, coated on the treated surface of the polymer skin layers...." [Abstract, lines 1 to 10]

The surface temperature of the polymer skin layer produces a separate surface layer that is not the same as the polymer skin layer and that is located between the metal layer and the polymer skin layer. This separate surface layer resulting from the surface treatment is a critical feature of the Touhsaent invention and cannot be eliminated without destroying the Touhsaent invention. This mandatory separate surface layer is excluded by applicants' claimed invention. Accordingly, the combination of Touhsaent and Kay cannot result in applicants' claimed invention.

The Office Action stated that, in response to applicants' argument that the claimed invention excludes a surface treated polymer skin layer between the metal layer and the melt extract, the Examiner agrees that Touhsaent requires the skin layer, however the claims do not exclude the skin layer. Applicants traverse this

statement because the claims are closed and exclude any layer, including a skin layer, between the (B) metal foil and (C) the multilayered plastic layer.

The Office Action stated that, although Claim 15 is written with consisting of language, it is not fully closed. The Examiner is clearly in error on asserting that Claim 15 is not fully closed. There are no legal decisions cited by the Examiner to support his wrong position. The term "consisting of" fully closes all that follows. If it is not positively recited, it is excluded. The Examiner has incorrectly ignored the meaning of the subject transitional phrase.

Chisum, *ibid.*, page 8 – 101, footnote 8, states:

"...; nonchemical as well as chemical cases); *Ex parte Davis*, 80 USPQ 448 (Pat. Off. Bd. App. 1949) ("the word 'consisting' in a claim is construed as definitely excluding therefrom any element or ingredient not specified therein.")" [Emphasis Supplied]

The Examiner has consistently made the error inserting the transitional phrase "comprising" or "consisting essentially of" into the fully closed body of applicants' claims. If it isn't specifically recited, it isn't in Claim 15.

The Office Action stated that the layer (C) of Claim 15 is a multi-layered plastic layer, which in its broadest interpretation is defined as a multi-layered laminate having plastic in the layers. Applicants traverse this erroneous statement. Layer (C) is defined by the positive recitation of containing layers (D) and (E) and nothing else [except for the positively recited optional layers (F) and (G)]. Layers (D) and (E) positively recite what they are. They are closed to anything else, such as, the surface treated polymer skin layer of Touhsaent.

The transitional phrase "consisting of" excludes anything between (A) metal foil and (D) layer of a lacquer coating or a melt extrusion. Therefore, the Examiner's assertion is further shown to be in error.

The Office Action stated that, in the claims, layer (C) goes on to be defined as being "made from" a layer of a lacquer coating or melt extrudate and a non-adhesive film containing a polyolefin. Since layers (D) and (E) [and optional layers (F) and (G)] are the only elements that are positively recited as being part of multilayer (C) so multilayer (C) can only contain layers (D) and (E) [except for the positively recited optional layers (F) and (G)] because the body of Claim 15 is fully closed by the transitional phrase "consisting of".

The Office Action stated that "made from" is considered open language, so therefore, although the claims are limited to only A to E and optionally F and G, C is open to multiple layers. Applicants traverse this statement because only positively recited layers (D) and (E) [and optional layers (F) and (G)] are contained in multilayered (C). Nothing else can be contained in multilayered (C) because nothing else is positively being recited in multilayered (C). The Examiner has consistently and incorrectly distorted the legal meaning of "consisting of". Multilayered (C) is open only to what is positively (definitively) recited as being present in it. Nothing else can be present in multilayered (C).

Webster's Ninth New Collegiate Dictionary, (1989), page 779, states:

"multi ... 1 a:....multiple: ... c: more than one ..."

"multiple ... 1 : consisting of, including, or involving more than one ..."

Multilayered can mean two layers which is how Claim 15 defines multilayered (C) by positively reciting only layers (D) and (E) [except for the optional layers (F) and (G)].

The Office Action stated that Touhsaent teaches a multi-layered plastic, which relates to C, made from polymer skin layer, melt extrudate, and a polymer core layer and because C is defined in the claims in open language the multi-layered plastic of Touhsaent reads on the multi-layered plastic of the instant invention. Applicants traverse this statement because it is clearly in error and violates the meaning of the transitional phrase "consisting of" as clearly shown above. Layer (C) is not, and cannot be, open because the entire body of Claim 15 is closed except to the definitively specified elements.

The Office Action moved on to respond to applicants' arguments that if a printed ink pattern is placed in Touhsaent to fit the optional limitations presented in the claims an over-lacquer coating would also be added. Column 2 of Touhsaent states "a printed ink may be applied" and continues "with an overlayer applied to the surface of the printed pattern". The term "may" applies to the printed ink, not to the overlayer. When the former is applied, the latter has to then be applied to the former.

The Office Action stated: that, first, Touhsaent does not require an overlacquer coating on the printed ink pattern; and that column 7, lines 1 to 10, of Touhsaent teaches that an overlacquer layer "may" be applied to the printed pattern to prevent the pattern from damage. Since column 2 of Touhsaent says that the overlacquer has to be applied onto the printed ink pattern, Touhsaent has

contradictory teachings. Such being the case, the Examiner has no basis to choose the disclosure in column 7 over the mandatory teaching of column 2. In fact, the mandatory teaching of column 2 is the one that one ordinarily skilled in the art would choose as being the controlling teaching of Touhsaent (if either could be chosen) because it is part of the "Summary Of The Invention".

The Office Action stated that, second, the multilayered plastic layer (C) includes other layers besides D, E, and optionally G because the layer (C) is described in open language. Applicants traverse this statement as being in error, and have shown above that layer (C) is not open and does not even contain open language. The Examiner keeps violating the meaning of the transitional phrase "consisting of".

The Office Action stated that, therefore, the overlacquer layer of Touhsaent over the printed ink pattern disposed on the surface of layer (E) would be included in the open language of multilayered plastic layer (C). The Examiner's statement is fatally defective. Layer (C) is closed to that which is definitively stated as layers (D) and (E) [plus optional (F) and (G)]. Column 2 of Touhsaent is controlling and requires an overlacquer on its printing ink pattern.

The Office Action moved on to respond to applicants' argument that the treated surface of the skin layer is in contact with the metal layer and comprises a separate layer. The Figure of Touhsaent shows that it is a separate layer (even being labeled as such).

The Office Action stated that, although Claim 15 does have "consisting of" language, the multilayered plastic layer (C) is defined in open language, which

therefore would include the skin layer and the surface treated skin layer within the multilayered plastic layer. Applicants traverse this statement because layer (C) is not open as established above.

The prior Office Action stated that, however, Kay teaches that a surface relief structure is embossed into a lacquer layer (Col. 3, lines 28 to 35) which has a metal deposit layer of aluminum coated on the lacquer layer (Col. 3, lines 5 to 12), in order to generate an optically variable light effect such as a regular diffraction grating or a mosaic of diffracting gratings, such as, a damask pattern or small worm design (col. 3, lines 5 to 21), in order to render the packaging film tamperproof. This statement is not a full recitation of the required components of the Kay invention.

The prior Office Action stated to see the abstract. Kay states:

"A tamper indicating security item such as a shrink wrap seal comprises a substrate including an optically variable effect generating structure such as an embossed hologram. Each surface of the substrate carries an adhesive having a strength that after the substrate has been adhered to a surface it cannot be removed without damaging the optically variable effect generating structure." [Emphasis Supplied]

[Abstract, lines 1 to 7]

See also, for example, Claim 1, column 2, lines 13 to 22, 29 to 31 and 62 to 67, column 4, lines 17 to 23, column 6, lines 3 to 33, column 7, lines 5 to 16, and Figure 1 of Kay. The tamper indicating security item of Kay requires at least one surface that is an adhesive layer; that is not covered by a reasonable layer.

Elimination of such required uncovered adhesive surface would destroy the Kay invention. Both surface layers of applicants' claimed invention must be non-adhesive layers. The combination of Touhsaent and Kay means that such combinations must have at least one surface that is an uncovered adhesive — the result is not applicants' claimed invention. The Examiner has not shown why such critical feature of the Kay invention can be eliminated in combining Touhsaent and Kay in the quest for applicants' claimed invention. Applicants' claimed invention is unobvious.

The Office Action moved on to respond to applicants' argument that Kay cannot be combined with Touhsaent to meet the limitations of the instant claims, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Applicants traverse this statement as being a clearly incorrect statement of the law. All of the prior art teachings of record must be considered under 35 U.S.C. 103(a), and none of the teachings can be ignored by the Examiner unless the Examiner has compelling facts/reasons to do so in the record. If inclusion of Kay into Touhsaent would destroy the invention of Touhsaent, then the attempted combination of rejection references fails with the result of unobviousness.

The Examiner has incorrectly described applicants' position. Even if combination of the prior art references was suggested to one ordinarily skilled in the art, the Examiner has not established that any part of Kay can be excluded from the combination of rejection references.

The Office Action stated: that, rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art; and see MPEP 2145, III. The combined teachings include all of the combination of teachings to one ordinarily skilled in the art. As shown above, said combination of teachings of the rejection references does not result in applicants' claimed invention. M.P.E.P. 2141.02 states it must be considered in its entirety, including disclosures that teach away from the claimed invention.

Furthermore, the Examiner does not know what would be suggested to, or any other matter, to one ordinarily skilled in the art. The Examiner has not made in the record the mandatory factual resolution of the level of skill of one ordinarily skilled in the art. Without such mandatory factual determination, the Examiner knows nothing about one ordinarily skilled in the art or what such a person would or would not do, would or would not be suggested of, or anything else concerning such a person. This obviousness rejection is, accordingly, fatally defective.

The Office Action stated that, in this case, the combined teachings of the references suggest to those of ordinary skill in the art that the invention of Touhsaent would be modified by embossing the metal layer in order to provide the overall laminate of Touhsaent tamperproof, as taught by Kay. Applicants traverse this statement. The Examiner does not know who is one ordinarily skilled in the art so the Examiner does not know what the combined teaching would suggest to one ordinarily skilled in the art. The Examiner has not factually shown in the record why one ordinarily skilled in the art would ignore/exclude any of the teachings of Kay. As shown above, the combination of Touhsaent and Kay results

in an entity that has an uncovered adhesive on at least one surface — such result is not applicants' claimed invention.

M.P.E.P. 2143.01 states that a combination of rejection references cannot be used if it renders the primary reference inoperable for its intended purpose.

The invention of Touhsaent would be rendered inoperable as a metallized multilayered packaging film having at least one adhesive surface layer that would stick to the contents or other packaging (unless subsequently covered by a further layer, with the result being further outside of applicants' claim invention).

The prior Office Action stated that one of ordinary skill in the art would have recognized that metallized packaging films have an embossed design over whole or part of the surface of the metal foil layer, in order to render the packaging film tamperproof, as taught by Kay. Application of Kay to Touhsaent would destroy the Touhsaent invention as Touhsaent does not seek to adhere its laminate to a product and a heat shrinkable film. The Examiner does not know what one ordinarily skilled in the art would recognize.

The prior Office Action stated that, regarding the thickness of the individual layers in Claims 17 and 21, one of ordinary skill in the art would have recognized that the optimum thickness for the layers of the laminate would be determined through routine experimentation depending on the intended end result of the laminate. Applicants traverse this statement. Section 103(a) requires facts, not speculation as to what so called routine experimentation might or might not achieve. The Examiner does not know what one ordinarily skilled in the art would

recognize (because the Examiner does not know who is one ordinarily skilled in the art).

The prior Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to form the metal foil layer of Touhsaent with an embossed design over the whole or part of the surface, in order to render the packaging film tamperproof, as taught by Kay. Applicants traverse this statement. The Examiner has not factually shown in the record the necessary motivation for one ordinarily skilled in the art to combine Touhsaent and Kay in the search for applicants' claimed invention. The opposite is the actual situation as both rejection references direct away from applicants' claimed invention. Furthermore, the combined rejection references do not result in applicants' claimed invention. The Examiner has not established why any of the required features, teachings, etc. of the rejection references can be ignored and discarded in the search for applicants' claimed invention. Also, the Examiner does not know who one ordinarily skilled in the art is, so he does not know what would be obvious to one ordinarily skilled in the art.

The Office Action moved on to respond to applicants' argument that it would not have been obvious to one having ordinary skill in the art to arrive at the thickness of the layers claimed. The Examiner does not know what would have been obvious to one ordinarily skilled in the art.

The Office Action stated that Touhsaent teaches that the sealable coating is provided in a thickness that is sufficient to impart the desired sealability, coefficient

of friction, and hot slip characteristics to the laminate (Col. 6, lines 60 to 63). This statement is nebulous as to layer thickness.

The Office Action stated that, therefore, one of ordinary skill in the art would have recognized that as suggested by Touhsaent, routine experimentation would be required to determine the optimum thickness of the coating for the intended use of the laminate. Applicants traverse this statement. The Examiner does not know what would be recognized by one ordinarily skilled in the art (let alone who is such a person or the level of skill of such a person). The approach of using so-called routine experimentation to optimize is meaningless under Section 103(a) because it conforms to the mandatory requirements of the Graham decision.

The Office Action stated that Touhsaent further teaches that the multilayered plastic layer has a thickness in the range of 12.7 to 76 micrometers, in which the core layer or non-adhesive film containing a polyolefin comprises 80 to 99 percent of the thickness.

The Office Action stated that, therefore, it would have been obvious to one having ordinary skill in the art that film containing at least one polyolefin would have a thickness between 10 micrometers and 75 micrometers and the melt extrudate would be much less because it is merely the interface between the core layer and skin layer and would be determined based on the thickness of the skin and core layers (Col. 4, lines 14 to 25). The Examiner does not know what would be obvious to one ordinarily skilled in the art as he has not factually defined in the record who such a person is and the level of skill of such person. It is too late now

for the Examiner to correct this fatal error in this rejection because he has given final status to this rejection.

The Office Action stated that one of ordinary skill in the art would have recognized that the lacquer coating found in the functional layer would be much thinner than the sealable coating and would be determined to be only thick enough to prevent damage of the ink pattern. The Examiner does not know who one ordinarily skilled in the art is, so the Examiner cannot know what one ordinarily skilled in the art would recognize.

The Office Action stated that, as seen in the Figure, the core layer makes up the majority of the film and, therefore, all of the other layers would be thinner than the polymer core layer. Maybe yes, maybe no. Patent drawings are not engineering drawings and are not required to be anything but illustrative without requirement of comparative dimensions.

The Office Action stated that, therefore, one of ordinary skill in the art would have recognized that all of the other layers would have a thickness less than 75 micrometers, including the metal deposit layer, which would be determined by scaling the thickness to relate to the polymer core layer's thickness. The Examiner does not know what one ordinarily skilled in the art would recognize.

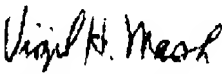
The Examiner has not carried his burden of proof. The Examiner also has not factually established in the record a *prima facie* showing of obviousness.

The Examiner has never even asserted that he had factually established in the record a *prima facie* showing of obviousness, or that applicants had not successfully rebutted any such showing.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,


Virgil H. Marsh
Reg. No. 23,083

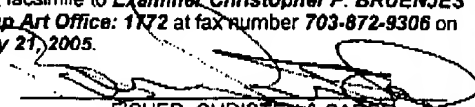
DATE: Jan. 21, 2005

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile to Examiner Christopher P. BRUENJES of Group Art Office: 1172 at fax number 703-872-9306 on January 21, 2005.


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